

REMARKS

It is noted that the first form page of the Office Action indicates that it is a non-final action but that the text of the action states that it is a Final action. Because the sole rejection is a repeated rejection and this is the second Office Action, it is assumed that the action is Final. If not, clarification is requested.

The Amendments

The claims are amended to correct some obvious minor informalities. The amendments do not narrow the scope of the claims and/or were not made for reasons related to patentability.

It is submitted that the above amendments would put the application in condition for allowance or materially reduce or simplify the issues for appeal. The amendments do not raise new issues or present new matter and do not present additional claims. They merely correct some obvious errors. They were not earlier presented because the application was just recently transferred to the undersigned new representative and this was the first occasion for the new representative to review the claims. Accordingly, it is submitted that the requested amendments should be entered.

The Obviousness-Type Double Patenting Rejection

The rejection of claims 26-46 for obviousness-type double patenting over U.S. Patent No. 5,698,634 is respectfully traversed.

The claims of the '634 patent do not encompass nor do they suggest a method according to applicants' claims because there is no use or suggestion in the '634 claims of a catalyst such as applicants' hydride complex of a trivalent metal. The '634 claims are clearly

distinguished in that the Ln metal is substituted by a group, R⁴, and optionally by a (Donor) group, neither of the R⁴ or (Donor) groups encompass or suggest the group, H, to provide a hydride complex.

The apparent position taken in the Office Action is that the Ln-R⁴ group and/or the Ln-(Donor) group in the catalyst used in the '634 claims would generate the anion H⁻ and, thus, work the same as the catalyst of the instant claims. It is further alleged in the Office Action that there is a "burden on applicants to present evidence" that the hydride complex of their catalyst works different from the catalyst of the '634 claims. Applicants respectfully submit that these allegations are not supported by the facts, nor do they have proper legal basis.

First, there are absolutely no teachings of record or scientific basis to support the allegation that the Ln-R⁴ group of the '634 catalyst would generate the anion H⁻ or that, even if there was such generation, it would provide a hydride complex according to applicants' claims. The '634 claims and disclosure certainly provide no basis for such a conclusion. Furthermore, as to the (Donor) group in the '634 catalyst, even if a H⁻ anion were supplied thereby, the resulting catalyst would still be distinct from applicants' catalyst in that it would still contain the R⁴ group which is not in applicants' catalysts. Additionally, the '634 patent gives no hint to one of ordinary skill in the art how a hydride catalyst of the instant claims would be prepared. Finally, it is pointed out that the '634 patent is in the same patent family as EP-A-0634429 which is discussed at page 2 of the instant specification. The disclosure indicates that the catalysts of the reference provide copolymers which are inferior to those obtained using applicants' catalysts. That different and inferior results are obtained with the reference catalysts further confirms their distinct nature.

Second, it is contrary to established law to shift the burden upon applicants to provide evidence showing how their claimed invention is distinguished from the prior art. The burden lies with the PTO to provide evidentiary basis supporting any ground of rejection. There is no basis on the current record to conclude that the Ln-R⁴ group or Ln-(Donor) group of the '634 catalysts convert, somehow, to provide a hydride complex of the trivalent metal. The burden lies with the PTO to provide some objective reasoning for why such a conversion would occur or to provide some teaching in the art which would suggest that applicants' hydride complex is an obvious variant of the '634 catalysts, e.g., that one of ordinary skill in the art would be motivated from the '634 catalysts to provide applicants' catalysts. The PTO has not met its burden in any of these respects. It is improper for the PTO to shift the burden upon applicants to disprove an allegation that the hydride is provided by the prior art catalysts when there is absolutely no basis on the record to support this allegation in the first place.

For these reasons, at least, the obviousness-type double patenting rejection should be withdrawn.

As an additional basis for withdrawal of the rejection, the '634 claims also do not recite the first isotactic block aspect of the instant claims. The arguments previously made on this point are incorporated by reference. The Office Action states that the first α -olefin block recited in the '634 claims would encompass isotactic blocks. However, the '634 claims and disclosure provide no suggestion to one of ordinary skill in the art towards an isotactic embodiment or the means by which such result could be achieved.

It is noted that the '634 patent would qualify as 35 U.S.C. § 102(b) prior art to the instant application but that no prior art-based rejection was made. If such a prior art-based rejection is further considered, it is noted that the above distinctions made in traversing the

obviousness-type double patenting rejection would analogously apply in distinguishing the '634 patent for prior art purposes from the instant claims.

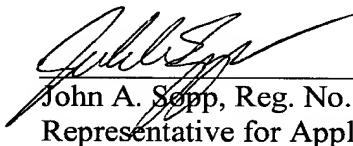
The Information Disclosure Statement

The remarks in the Office Action on page 5 indicating that the references cited in the corresponding PCT search report have been considered are noted. As requested in the Office Action, attached is a PTO Form 1449 listing all of those considered references submitted for the purpose of having all of the already-considered references listed on an eventual patent for this application.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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